

REMARKS

Counsel for the applicant appreciates the courtesy of the telephone interview on March 19, 2008.

Claims 1-5 and 13-17 are pending in the instant application. Applicant respectfully requests reconsideration and allowance of this application in view of the following remarks.

Claims 1-5 and 13-17 were rejected under 35 USC 112, first paragraph, as failing to comply with the enablement requirement, particularly with respect to the limitation "over respective adjacent channels." At the telephone interview, the examiner particularized the term "adjacent" as eliciting the rejection. Independent claims 1 and 13 have been amended to receive "receiving respectively each of a primary, a secondary and a tertiary synchronization code in parallel over respective ~~adjacent~~ channels during a first symbol time in each of said predetermined number of time slots." Support for the amended wording is located in the application as filed, for example, page 1, line 22 to page 7, line 1; FIG. 5; and the circuit shown in FIG. 1 per page 6, lines 27-28 with reference to page 3, lines 11-12. It is respectfully requested that the rejection under 35 USC 112, first paragraph be withdrawn, with respect to the amended claims.

Claims 1-5 and 13-17 were rejected under 35 U.S.C. §103(a) as being unpatentable over Allegedly Admitted Prior Art ("AAPA") in view of U.S. Patent No. 6,185,244, Nystrom et al. ("Nystrom"). Insofar as the rejection may be applied to the claims as amended, the applicant respectfully requests that this rejection be withdrawn for reasons including the following, which are presented by way of example.

To properly reject a claimed invention, the examiner must establish a *prima facie* case of obviousness. To establish a *prima facie* case of obviousness with respect to a claimed invention,

all the claim limitations must be taught or suggested by the reference (or references when combined). *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). Moreover, it is necessary to identify the reason why a person of ordinary skill in the art would have combined allegedly known elements in the manner claimed. *KSR Int'l Co. v. Teleflex, Inc.* 550 U.S. ___, 82 U.S.P.Q.2d 1385 (2007). The examiner bears the burden of establishing this *prima facie* case. *In re Deuel*, 34 U.S.P.Q.2d 1210, 1214 (Fed. Cir. 1995). The applicant for patent may then attack the *prima facie* case as improperly made out, or present objective evidence tending to support a conclusion of nonobviousness. *In re Fritch*, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992). If the examination at the initial stage does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of patent. *In re Oetiker*, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992).

The applicants provide herein a selection of some examples of limitations in the claims which are neither taught nor suggested by AAPA. The Office Action admits that AAPA “does not specifically disclose and receiving synchronization code over respective adjacent channels during a first symbol time in each of said predetermined number of time slots.” (Office Action, page 4). Recognizing that AAPA fails to teach and/or suggest the invention as claimed, Nystrom is cited to remedy the deficiencies.

Nevertheless, Nystrom fails to remedy such deficiencies. The office action cites Nystrom, Col. 12, line 8 to Col. 13, line 25, and Figures 16-22 as being particularly relevant. Nystrom’s transmission of primary and secondary synchronization codes in parallel in each slot does not teach or suggest transmitting “a primary, a secondary, and a tertiary synchronization code” “during a first symbol time in each of said time slots.” Nystrom also fails to teach or suggest other elements recited in the claims.

However, the office action further contends that Nystrom in combination with AAPA teaches “allowing all the three synchronization codes be transmitted during a first symbol time in each slot.” In AAPA, the third synchronization code is “dedicated to frame synchronization.” (E., page 5, line 1.) Nystrom, however, uses the secondary synchronization code as a frame timing indication (FTI), (Col. 12, lines 61-62 (“In finding a valid SSC sequence, the FTI is inherently produced”), and has no use for the recited tertiary synchronization code. Thus, there is no teaching in Nystrom of doing anything with a third synchronization code.

The office action, however, contends that the relevant teaching of Nystrom is “an advantage of providing each synch code in each time slot during a first symbol time is better security because receiving synch codes during a second or later symbol time could be a little too late and may cause some problems.” No citation is provided, however, because there is no such teaching in Nystrom.

Furthermore, it is still necessary to identify the reason why a person of ordinary skill in the art would have combined allegedly known elements in the manner claimed. *KSR Int’l Co. v. Teleflex, Inc.* 550 U.S. ___, 82 U.S.P.Q.2d 1385 (2007). The office action identifies the reason that the teachings of AAPA would be modified by the teachings of Nystrom is for “allowing all the three synchronization codes be transmitted during a first symbol time in each slot ... for the purpose of providing a securer communication system.” The proposed modification of AAPA, however, does not articulate why the teachings of Nystrom regarding a secondary synchronization code should be modified to be applied to a tertiary synchronization code, a point which is important since Nystrom significantly teaches that another synchronization code for frame timing is superfluous. The teaching of Nystrom away from using a third synchronization code is a significant indication that the claims are patentable over the references.

Put another way, the office action essentially contends the Nystrom teaches a species of secondary synchronization codes, and from that extrapolates that Nystrom teaches a genus of n synchronization codes. However, the applicant is not reciting the genus of n synchronization codes. Neither does Nystrom envisage a genus of n synchronization codes. Therefore Nystrom's species of secondary synchronization codes cannot be regarded as teaching the recited species including tertiary synchronization codes. (See MPEP 2131.02 regarding genus-species.)

Hence, AAPA and Nystrom, alone or in combination, fail to teach or suggest the combination of features recited in the independent claims, when considered as a whole.

With respect to the rejected dependent claims, applicant respectfully submits that these claims are allowable not only by virtue of their dependency from the independent claims, but also because of additional features they recite in combination.

Dependent claim 5 recites that "a mobile receiver identifies a first time slot of the frame by the tertiary synchronization code." Nystrom, to the contrary, discloses use of the secondary synchronization code (SSC) as a frame timing indication (FTI), (Col. 12, lines 61-62 ("In finding a valid SSC sequence, the FTI is inherently produced"). Since Nystrom already uses the secondary synchronization code as a frame timing indication, there is no reason why one would use Nystrom's teachings to modify AAPA's teachings. Accordingly, the combination of elements recited in claim 5 is non-obvious over AAPA if modified as proposed by Nystrom.

Dependent claim 17 recites that "the tertiary synchronization code order corresponds to an order of time slots in the frame." Nystrom, to the contrary, discloses use of the secondary synchronization code (SSC) as a frame timing indication (FTI), (Col. 12, lines 61-62 ("In finding a valid SSC sequence, the FTI is inherently produced"). Since Nystrom already uses the secondary synchronization code as a frame timing indication, there is no reason why one would

use Nystrom's teachings regarding the secondary synchronization code to modify AAPA's teachings. Accordingly, the combination of elements recited in claim 17 is non-obvious over AAPA if modified as proposed by Nystrom.

Applicant respectfully submits that, as described above, the cited art does not show or suggest the combination of features recited in the claims. Applicant does not concede that the cited art shows any of the elements recited in the claims. However, applicant has provided specific examples of elements in the claims that are clearly not present in the cited art.

Applicant strongly emphasizes that one reviewing the prosecution history should not interpret any of the examples applicant has described herein in connection with distinguishing over the cited art as limiting to those specific features in isolation. Rather, for the sake of simplicity, applicant has provided examples of why the claims described above are distinguishable over the cited references.

In view of the foregoing, the applicant submits that this application is in condition for allowance. A timely notice to that effect is respectfully requested. If questions relating to patentability remain, the examiner is invited to contact the undersigned by telephone.

If there are any problems with the payment of fees, please charge any underpayments and credit any overpayments to Texas Instruments Incorporated's Deposit Account No. 20-0668.

This Amendment is submitted by the undersigned registered patent attorney in accordance with 37 CFR 1.34.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Cynthia K. Nicholson', written over a horizontal line.

Cynthia K. Nicholson

Reg. No. 36,880

Texas Instruments Incorporated
P.O. Box 655474
MS 3999
Dallas, TX 75265
Customer No. 23494